

RESPONSE

Examiner: FISCHER, Andrew J.

Serial No. 09/769,294

Atty. Docket No.: 53881.010100

REMARKS/ARGUMENTS

Claims 1-3 and 5-19 are currently pending in the above-referenced application. Entry and consideration of this paper is respectfully requested. Claim 1, 9, 10, 12, 13, 15, and 19 are amended herein. Claim 17 has been canceled.

Applicant hereby incorporates by reference the arguments set forth in the previous Response.

In the Office Action, the Examiner rejected the currently pending claims. Applicant respectfully traverses the Office Action, including the rejections, the Examiner's factual determinations, and the Examiner's arguments in their entirety for at least the reasons set forth below.

At the outset, Applicant wishes to note on the record the Examiner's open hostility to the Applicant and Applicant's claimed invention. Applicant notes that Applicant has consistently attempted to deal civilly with the Examiner, only to be met with inflammatory language including accusations of failure to meet Applicant's duty of candor; case law cited as holding something which a legally trained person who actually read the entire case, rather than the mere excerpts the Examiner chose to take out of context, would acknowledge were at least irrelevant to the rejection at hand, or worse actually held the opposite of the Examiner's position; and other such tactics. The Examiner's supervisor has spoken with the Examiner about some of the Examiner's past actions, and this has further colored the Examiner's view of the instant application. The result is Office Actions such as the current Office Action, and Applicant respectfully objects to the Examiner's tone and demeanor therein, and respectfully requests that a new, less biased Examiner be assigned to the case. Applicant is also filing herewith a Pre-Appeals Conference Request and the accompanying Brief in an effort to settle some of the outstanding issues in the instant prosecution.

Response to Rejections Under 35 U.S.C. §112, 2nd Paragraph

The Examiner rejected claims 1-3 and 5-19 under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In making this rejection, Examiner asserted that "the claims are replete with errors". Applicant respectfully traverses the rejection, and the

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associated characterization of the claims, and respectfully requests that the Examiner withdraw these characterization.

Turning to the specific rejections, the Examiner rejected the phrase "corresponding on-hand inventory item quantities" as used in Claim 12 under 35 U.S.C. §112, 2nd paragraph as being indefinite because "it not known in reference to what the 'corresponding' is referring to". The element in which the subject phrase appears reads "recording any received or returned inventory items and incrementing corresponding on-hand inventory item quantities in the inventory database". To assist the Examiner in properly interpreting this claim element, and the term "corresponding" as used therein, Applicant suggests that the Examiner review the database-related materials cited in the instant application. As the Examiner will learn, although databases can take many forms, databases are typically made up of at least one "table", wherein the table is comprised of columns and rows similar to a spreadsheet. When described with respect to such a database, each "row" of the table represents a particular database entry, such as a particular make and model of automobile, a particular vintage and type of wine, an individual customer, or the like. The table's "columns" are typically referred to as "fields", and each field represents a particular attribute corresponding to the database entry that is to be stored in the database. Exemplary fields include a customer's first name, the zip code for the customer's mailing address, or in the instant application, the quantity of a given inventory item that is on hand, on reserve, or on order. In the instant claim element, the term "corresponding" represents the relationship between the on-hand inventory item quantity field in the database and the inventory item database entry. With this explanation in mind, it should be clear to the Examiner that the subject claim element recites incrementing the on-hand inventory item quantities corresponding to any received or returned inventory items as the inventory items are received. Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner further rejected Claim 12 under 35 U.S.C. §112, 2nd paragraph as being indefinite because "it is unclear if 'shipment' in reference to a 3rd party shipping inventory 'to' operator of the database or, alternatively, shipping inventory 'out from' or 'away from' the operator of the database." Applicant respectfully traverses the rejection and asserts that, especially in light of paragraph [0019] of the specification as published, the interpretation of

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the term "shipment" is self-evident. The element in which "shipment" appears reads, in pertinent part, "decrementing both reserve and on hand inventory item totals in the inventory database upon shipment". In this context, shipment clearly refers to the shipping of inventory 'out from' or 'away from' a warehouse or other storage location which the operator of the database is monitoring. To decrement both reserve and on hand inventory item totals in the database upon receipt (e.g. inventory items that a third party sent to the database operator's warehouse) is nonsensical in the current context, as this would lead to improper inventory tracking. Applicant therefore respectfully requests that the Examiner withdraw the rejection.

The Examiner further rejected Claim 12 under 35 U.S.C. §112, 2nd paragraph as being indefinite as the examiner was unclear of the relationship between the 'inventory item quantities' recited in line 3, the "at least one inventory item quantity" recited in line 15, and the "inventory item quantities" recited in line 10. Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution of the instant application, Applicant has amended Claim 12 to further clarify the language used therein. Applicant's amendment having rendered the Examiner's rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner still further rejected Claim 12 under 35 U.S.C. §112, 2nd paragraph as being indefinite because "it is not known which inventory items are within the 'corresponding' quantity of inventory items". Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution of the instant application, Applicant has amended Claim 12 to further clarify the language used therein. Applicant's amendment having rendered the Examiner's rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

With respect to Claim 1, the Examiner indicated that "it is unclear if 'a client' as recited in line 8 is included in the set of 'at least one client' recited in line 7". Applicant respectfully traverses the rejection. However, in an effort to expedite prosecution of the instant application, Applicant has amended Claim 1 to further clarify the language used therein. Applicant's amendments herein render the Examiner's rejection moot, and Applicant respectfully requests that the Examiner withdraw the rejection.

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Response to Rejections Under 35 U.S.C. §112, 1st Paragraph

In the previous Response, Applicant filed arguments with respect to the Examiner's previous rejections of Claims 12-19, and Claims 2 or 4, under 35 U.S.C. §112, first paragraph. The Examiner neither acknowledged the response nor reiterated the rejection. For the purposes of this response, it is assumed that the Examiner has withdrawn the rejection for the bases set forth in the previous Office Action.

The Examiner rejected Claims 1-3 and 5-19 under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement, and rejected Claims 1 and 12 as failing to comply with the enablement requirement. In particular, the Examiner argued that the specification does not necessarily disclose a server which provides real time access to inventory information stored in a database by pushing the inventory information to a client. Applicant respectfully traverses the rejection. However, Applicant's amendments have rendered the Examiner's rejection moot, and the withdrawal of the rejection is respectfully requested.

Response to Rejections Under 35 U.S.C. §102

The Examiner rejected Claims 1-3 and 5-19 under 35 U.S.C. §102 as being anticipated by Peterson, U.S. Patent No. 6,324,522. Applicant gratefully acknowledges the Examiner's concession in paragraph 14 of the Office Action that anticipation requires that the Examiner meet the "All Elements Test" and the Examiner's concession that Peterson does not meet this test, as evidenced by the Examiner's reliance on other grounds for making the rejection.

Because a straightforward analysis of Peterson will not permit the Examiner to maintain his anticipation rejection, the Examiner attempts to create new bases for an anticipation rejection. The Examiner cites a plethora of case law in support of his position. However, as in the previous Office Action, the Examiner's position is based on misconstrued case law. In paragraph 15 of the Office Action, the Examiner cites Standard Havens Prods. v Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed.Cir. 1991); In re Bell, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993); and In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) in support of his position that, in an anticipation analysis, "the use of patents as references is not limited to what the patentees

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describe as their own inventions or to the problems with which they are concerned". In re Heck. However, In re Heck and In re Bell are cases that deal with obviousness, not anticipation, and the Examiner's reliance thereon with respect to an anticipation rejection is improper. With respect to Standard Havens, the next sentence in the court's holding reads "Anticipation can occur when a claimed limitation is "inherent" or otherwise implicit in the relevant reference." (Standard Havens, 953 F.2d at 1369, 21 USPQ2d at 1328). Thus, Standard Havens stands for the position that a reference can anticipate a claim if the claimed limitation is inherent in the relevant reference.

Standard Havens also does not support the Examiner's subsequent position in paragraph 16 that the Examiner can combine that which is old and well known in the art in combination with a reference. In fact, although the Examiner has uncovered a single case, In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), that parrots back the language upon which the Examiner relies, no other cases rely on In re Graves for the position for which the Examiner cites it. Still further, as the court pointed out in Rockwell International Corp. v. SDL, Inc., 103 F.Supp.2d 1202 (N.D. Cal 2000), the court in In re Graves took the same quote upon which the Examiner relies out of context. In In re LeGrice, the case from which In re Graves quotes, the quotation establishes a standard for determining whether prior art is enabling, and has nothing to do with whether a prior art reference inherently discloses an apparently missing element. See Rockwell International, 103 F.Supp.2d at footnote 2. The same is true for the cited sections of In re Donohue, 766 F.2d 531 (Fed. Cir 1985). In fact, "the overwhelming majority of Federal Circuit cases" indicate that extrinsic evidence, as relied on by the Examiner, is "of limited scope and probative value [in an anticipation analysis], for a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference ... The court further pronounced that extrinsic evidence may only be used 'to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention *not to fill in the gaps in the references*.'" (Id at 1206, quoting Scripps Clinic & research Found. v. Genentech Inc., 927 F.2d 1565 (Fed.Cir. 1991)). Moreover "the question of whether 'one of ordinary skill may in reliance on the prior art complete the work required for the invention' ... relate[s] to obviousness, not anticipation" (Id at 1206, quoting Connell v. Sears, Roebuck &

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Co., 722 F.2d 1542, 1548 (Fed.Cir. 1983)). Therefore, the Examiner's basis for the 102 rejections is clearly improper, and Applicant respectfully requests that the Examiner withdraw the rejection.

Response to Rejections Under 35 U.S.C. §103

The Examiner alternatively rejected Claims 1-3 and 5-19 under 35 U.S.C. §103(a) as being unpatentable over Peterson, Green, and Gralla. It is the Examiner's principle position that the claims are anticipated because of what the Examiner presumes to be inherencies in Peterson. However, the Examiner argues in the alternative that if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Peterson as taught by Green to include the data structure as described in Green. The Examiner further asserts that "Such a modification would have simply disclosed that which is inherent". However, the Examiner's argument is illogical. The Examiner begins the alternative arguments with the presumption that the modifications subsequently relied on by the Examiner are not inherent. Applicant is unable to address the Examiner's arguments until the Examiner clarifies his position, and respectfully preserves the right to amend the arguments presented herein once such clarification is presented.

The Examiner also argues that a the modification of Peterson as taught by Green would have increased inventory accuracy, and the Examiner makes a factual determination that increasing accuracy of inventory helps prevent large alterations of profits and allows the purchasing staff to properly order replacement parts. The Examiner cites Bragg's Accounting Best Practices for this proposition. There are several errors in the Examiner's analysis. First, the Accounting Best Practices reference is not proper prior art under 35 U.S.C. §103. For a reference to be prior art under §103, it must also qualify as prior art under §102. The only section of §102 that applies in this case is §102(b), which states in pertinent part that "a person shall be entitled to a patent unless...the invention was ... described in a printed publication in this or a foreign country...more than one year prior to the date of the application for patent in the United States". As the Examiner is aware, an application is entitled to the benefit of the earliest priority date claimed when analyzed under §102(b). In this case, the instant application claims the benefit of Provisional U.S. Patent Application Serial No. 60/178,313, which was filed January 27, 2000. Therefore, for a

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reference to properly be prior art under §102(b), or consequently under §103, the reference must have been available prior to January 27, 1999. Applicant attaches hereto a copy of the description of the first edition of Accounting Best Practices from Amazon.com, a well known and well respected book reseller. According to Amazon.com, the book was not available until September 15, 1999. Therefore, Accounting Best Practices is not proper prior art with respect to the instant application.

Second, the Examiner asserts that because the determination “whether motivation to combine the references ... is a question of fact” (citing Winner Intl’ Royalty Corp. v. Want, 202 F.3d 1340 (Fed. Cir. 2000)), the Examiner can therefore make factual determinations based on the content of a proposed prior art reference. However, the Examiner is misconstruing the term “question of fact”. In the legal context, questions of fact are questions to be decided by a jury or other trier of fact. That is, the question is so murky that courts will not make a decision as a matter of law, but rather they leave the interpretation to others. Thus, the Examiner’s position that because motivation to combine is a question of fact grants the Examiner the right to invent a motivation to combine references is without basis.

Third, in issuing the rejection, the Examiner relies on Greene, however, the copy of Greene supplied by the U.S. Patent and Trademark Office contains only the cover page, cataloging data page, table of contents, and index. Applicant asserts that, if the Examiner wishes to continue to rely on Greene, copies of at least the appropriate sections of the text must be provided. Applicant respectfully reserves the right to amend this response when the appropriate reference is provided.

Given the many infirmities in the Examiner’s arguments, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner further asserts that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the combination of Peterson and Green as taught by Gralla. The Examiner states that “such a modification would simply have disclosed that which is inherent.” Applicant reasserts the arguments set forth above with respect to the Examiner’s inherency arguments. With respect to the combination of Peterson and Green with Gralla, Applicant asserts that Gralla teaches away

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from Applicant's claimed invention. As noted by the Examiner, Gralla teaches that "Because the information and pages are local instead of on the Internet they can be accessed when the user is not connected. They can also be accessed quickly because they're being read from a hard disk instead of across the Internet." Gralla essentially teaches that what the Examiner has characterized as "push" technology should be used to create a locally cached copy of the data. This is opposite of the intentions of Applicant's claimed invention - in Applicant's invention, it is important that the data be as current as possible. Locally cached copies are not displayed on the client because the information is inherently out of date. Gralla clearly teaches away from Applicant's claimed invention, and Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner rejected Claims 1-3 and 5-19 under 35 U.S.C. §103(a) as being unpatentable over Cornett (U.S. Patent No. 5,216,612) in view of Gralla. However, as set forth above, Gralla teaches away from Applicant's claimed invention, and therefore the combination of Gralla and Cornett is improper. Furthermore, the Examiner cites column 27, line 65 through column 28, line 3 of Cornett as teaching Applicant's claimed reserved stock. However, as used in Cornett, reserved stock is stock kept on hand in the event the inventory levels exceed anticipated demand. As defined in Applicant's specification and in the pending claims, Applicant's reserved inventory is inventory for which orders have been received, but which has not shipped. Neither Cornett nor Gralla teach or suggest all elements of Applicant's claimed invention, and Applicant respectfully requests that the Examiner withdraw the rejection.

Response to Examiner's Lexicography Arguments

Applicant respectfully asserts that the Examiner's resorting to dictionary definitions of claim terms, without first consulting Applicant's specification, is improper. "Thus, second, it is *always necessary* to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." "The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.... The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always highly relevant to the claim construction

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analysis. *Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.* " *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996) (emphasis added). The Examiner's use of the dictionary definitions, when faced with clear lexicographic intent in Applicant's specification, is improper.

Response to Examiner's Treatment of the Affidavits

The Examiner rejects the affidavits filed in conjunction with the previous Response because "the statements made therein are contradicted by the evidence of record". The Examiner goes on to quote excerpts from each of the affidavits in support of his position. However, when the entire portion of the affidavit is read, the affiants' position is not contradicted by the evidence of record. The affiants state that Peterson "cannot be seen as either explicitly or inherently disclosing the storage of on-hand, reserved, and ordered inventory information, nor would storage of such information have been obvious to one of ordinary skill in the art as of the priority date of the Pending Application". Affiants clearly state that the prior art does not teach a combination of all three types of inventory information, and the Examiner's mistreatment of the Affiants' statements is objected to. Applicant hereby reincorporates the Affidavits for the Examiner's consideration.

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CONCLUSION

Having responded to all rejections set forth in the outstanding Office Action, it is submitted that the currently pending claims are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

AUTHORIZATION

The Commissioner is authorized to charge any additional fees associated with this filing, or credit any overpayment to Deposit Account No. 50-0653. If an extension of time is required, this should be considered a petition therefor.

Date: March 22, 2006

Respectfully submitted,

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